

Remarks

The Examiner made her previous election requirement final and, based on the Applicant's preliminary election, proceeding with the examination of claims 9 and 10.

The Examiner rejected claims 9 and 10 under 35 U.S.C. §103(a) as being unpatentable over Bobrov-Egorov et al. in view of Yokoyama, Leontev et al., Karita et al., and Pike, and further in view of Zobitne et al. and Lawless. The Examiner stated that "Bobrov-Egorov teaches a composition comprising the following ingredients (wt. %): (i) an aromatizing component (0.5-20.0) comprising essential oil derived from mint, fir, coriander, anise, camphor, dill, cloves or fennel and containing a toning preparation (not more than 0.2% of base weight) comprising vanilla and/or oil extracted from filbert, chestnut, pine kernels, walnut, sea buckthorn and/or dog rose; oil extracts from everlastings, Leonorus, yarrow, celandine, thyme, Origanum, St. John's wort, peppermint, sage, dog rose fruit, coriander, caraway, horse chestnut, pine buds and calendula blossom (balance)...Bobrov-Egorov further teaches that the referenced composition has analgesic activity; and is useful in medicine, particularly gynecology." The Examiner further stated that "Bobrov-Egorov teaches the instantly claimed invention except for cornmint oil (although it is not clear as whether the mint oil taught by Bobrov-Egorov is not cornmint oil), orange oil, pennyroyal oil, and rosemary Spanish oil...[and that] it would have been obvious...to add the instantly claimed ingredients to the composition taught by Bobrov-Egorov to provided the claimed invention because...it was known in the art the analgesic effects of the claim designated essential oils." The Examiner still further states that Yokoyama teaches a composition "comprising an essential oil of *Mentha arvensis* an analgesic agent, which is also known in the art as cornmint, as

evidenced by the teaches of Zobitne.” Also, the Examiner states that “Zobitne...teaches that cornmint oil includes...alpha-pinene and beta-pinene...[and that] Law teaches that cornmint oil comprises methyl acetate.” Next, the Examiner states that Leontev teaches a composition having anesthetic activity comprising a Component I (camphor and mint oil) and a Component II (any of the following oils: coriander, orange, rose, peppermint, calendula, etc.). Next, the Examiner states that Karita teaches an analgesic oil composition comprising at least one oil selected from orange oil, grapefruit oil, mandarin oil and lemon oil, and one oil selected from lavender oil, lavandin oil and rosemary oil, and at least one oil selected from eucalyptus oil, chamomile oil, Taiwan hinoki and mugwort oil. The Examiner also states that Karita teaches that pennyroyal oil, *menthe arvensis* oil and rosemary oil are useful in making Karita’s analgesic composition. Next, the Examiner states that Pike teaches a composition for alleviating cramps, aches and pains, such as those associates with premenstrual syndrome, comprising pennyroyal oil. In sum, the Examiner states that one skilled in the art would have been motivated and would have had a reasonable expectation of success to add effective amounts of cornmint oil, orange oil, pennyroyal oil, and rosemary Spanish oil to Bobrov-Egorov’s composition to provide the Applicant’s claimed composition because Yokoyama, Leontev, Karita and Pike teach that these ingredients are use for reducing menstruation pain. Finally, the Examiner concludes that each of the references indicates that the various proportions and amounts of the claimed composition are result variables and they would have been routinely optimized by one of ordinary skill in the art.

The Applicant respectfully traverses the Examiner’s rejection as follows. In any obviousness determination, the patent examiner must determine the scope and content of the

prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the pertinent art, as established in *Graham v. John Deere*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). Patentability turns on whether the subject matter as a whole sought to be patented was obvious to one with "ordinary skill in the art to which the subject matter pertains" in light of the prior art. "In determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. §2141.02, citing, *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 U.S.P.Q. 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 U.S.P.Q. 698 (Fed. Cir. 1983).

To apply all the various references and Official Notices to the Applicant's claimed invention, as amended, is impermissible hindsight. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 10044, 1051-52, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988)(it is impermissible to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching or motivation in the prior art to do so); *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998)("rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention."). The Court of Appeals for the Federal Circuit in *Pentec, Inc. v Graphic Controls Corp.*, 227 U.S.P.Q. 766 (Fed. Cir. 1985), stated that "prior art may not be gathered with the claimed invention in mind". Similarly, in *In re Oetiker*, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992), the Court noted:

Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the Courts have recognized the subjective aspects of determining whether an inventor would reasonably be motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor . . . It is necessary to consider 'the reality of the circumstances', . . . - in other words, common sense - in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness.

24 U.S.P.Q.2d at 1446.

To begin, the Examiner acknowledges at the outset that the principal reference, Bobrov-Egorov, does not teach the first four components of the Applicant's composition. Bobrov-Egorov *also* does not teach menthyl acetate, alpha pinene, or beta pinene, and does not specifically teach camphor *white* oil. Out of the ten components of the Applicant's composition, Bobrov-Egorov only mentions three and arguably only two. With respect to Yokoyama, Yokoyama teaches a remedy comprising peppermint oil obtained by steam distillation of leaves, flowers, and stalks of *Mentha arvensis*. Yokoyama does not teach a remedy comprising cornmint oil.

With regard to the Zobitne reference, this reference is non-analogous art. Zobitne is directed at and discloses an insecticide and methods for controlling insect pests. The Court of Appeals for the Federal Circuit addressed the problem of analogous-non-analogous art. In Pentec, Inc. v Graphic Controls Corp., 227 USPQ 766 (Fed. Cir. 1985), the Court stated that "prior art may not be gathered with the claimed invention in mind". Similarly, in In re Oetiker, 24 USPQ 2d 1443 (Fed. Cir. 1992), the Court noted:

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subjective aspects of determining whether an inventor would reasonably be motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor . . . It is necessary to consider 'the reality of the circumstances', . . . - in other words, common sense - in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness.

24 USPQ 2d at 1446.

In In re Deminski, 230 USPQ 313 (Fed. Cir. 1986), the Court adopted a "two-step test" for determining whether particular references are within the appropriate scope of the art. First, it must be determined whether the reference is "within the field of the inventor's endeavor". Second, assuming the reference is outside that field, it must be determined whether the reference is "reasonably pertinent to the particular problem with which the inventor was involved". Insecticides are not pertinent to analgesics. As such, Zobitne is non-analogous art and thus may not be used to find the claims obvious.

With respect to Lawless, although Lawless teaches that cornmint *leaves*, in part, constitute menthyl acetate, such a limited teaching does not equate to a teaching that "Lawless teaches that cornmint oil comprises menthyl acetate" and certainly does not equate to teaching a composition that comprises menthyl acetate as a separate component from cornmint oil.

Next, the Examiner stated that Leontev teaches a composition having anesthetic activity comprising a Component I (camphor and mint oil) and a Component II (any of the following oils: coriander, orange, rose, peppermint, calendula, etc.). However, a reading of Leontev discloses that actually Leontev teach mixing camphor with and essential oil concentrate (I, made up of equal ratios of mint oil and any number of Leontev's listed oils including orange

oil) with an oil extract base (II which uses vegetable oil to extract Leontev's list of herbs). As such, the only additional component taught by Leontev is orange oil, even assuming for argument that combining Leontev with Bobrov-Egorov was not impermissible hindsight.

Next, the Examiner states that Karita teaches an analgesic oil composition comprising at least one oil selected from orange oil, grapefruit oil, mandarin oil and lemon oil, and one oil selected from lavender oil, lavandin oil and rosemary oil, and at least one oil selected from eucalyptus oil, chamomile oil, Taiwan hinoki and mugwort oil. The Examiner also states that Karita teaches that pennyroyal oil, *menthe arvensis* oil and rosemary oil are useful in making Karita's analgesic composition. Next, the Examiner states that Pike teaches a composition for alleviating cramps, aches and pains, such as those associates with premenstrual syndrome, comprising pennyroyal oil. Together, Karita and Pike similarly only teach two additional components, rosemary oil and pennyroyal, and arguably only pennyroyal, assuming for argument that combining Leontev with Bobrov-Egorov was not impermissible hindsight.

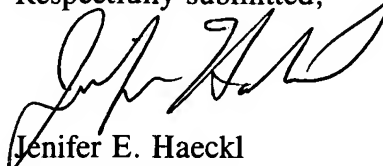
In short, none of the references suggests the claimed composition and, even when improperly combined, the references do not teach all of the components of the Applicant's composition. See, *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Most certainly, none of the references, or an improper combination of the references, teach or suggest the specific amounts recited in claim 10. For all of the above reasons, claims 9 and 10 are not obvious in view of Bobrov-Egorov in combination with the many other cited references.

Each of the Examiner's rejections has been addressed. Accordingly, it is respectfully submitted that the application is in condition for allowance. Early and favorable action is

requested.

If for any reason this Response is found to be incomplete, or if at any time it appears that a telephone conference with counsel would help advance prosecution, please telephone the undersigned in Worcester, Massachusetts at (508) 791-8500.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jennifer E. Haeckl", written in a cursive style.

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